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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,513	02/20/2004	Michael L. Obradovich	9800.1038	7591

7590

06/18/2004

Alex L. Yip
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New York, NY 10022

EXAMINER

LOUIS JACQUES, JACQUES H

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/783,513

Applicant(s)

OBRADOVICH ET AL.

Examin r

Jacques H Louis-Jacques

Art Unit

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-- The MAILING DATE f this c mmunication appears on the c ver sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 022004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 13-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 95-99 of U.S. Patent No. 6,009,355 in view of Love et al [5,629,871]. The claims of the '355 patent recite all the limitations except for the display as to facilitate maintenance as recited in the claims of the present application. However, Love et al discloses a wear trend analysis technique for components of a dialysis machine, wherein there is provided a device for displaying a selectable option on a display element, a selection of the information using information about an alert, thereby facilitating maintenance of the machine. Therefore, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the method and apparatus for providing information concerning maintenance of an engine in a vehicle of the '355 patent by incorporating the display from the system of Love because such modification would facilitate monitoring of the machine, thereby avoiding risks.

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3. Claims 13-22 are also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 95-99 of U.S. Patent No. 6,009,355 in view of Hanson et al [5,317,998]. The claims of the '355 patent recite all the limitations except for the display as to facilitate maintenance as recited in the claims of the present application. On the other hand, Hanson et al discloses a system and method of monitoring a vehicle, wherein there is provided a device (e.g., display 44) for displaying a selectable option on a display element, a selection of the information using information about an alert, thereby facilitating maintenance of the machine. Therefore, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the method and apparatus for providing information concerning maintenance of an engine in a vehicle of the '355 patent by incorporating the display from the system of Love because such modification would enable to more effectively carry out the purposes and functions of the apparatus

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 13-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al [5,317,998].

Hanson et al discloses a system and method of monitoring vehicle for maintaining components of the vehicle, wherein the system including a display element (44). According to Hanson et al, there is provided computing a measure which indicates an extent of performance degradation of a vehicle component (e.g., engine 22) due to an operation of the vehicle; adding the measure to a cumulative measure; determining whether the cumulative measure exceeds a predetermined value (column 14); providing an alert when the cumulative measure exceeds the predetermined value (column 14); and displaying a selectable option on the display element, a selection of the option causing information about the alert to be provided, thereby facilitating maintenance of the vehicle component (figure 1, 22 and column 4. According to Hanson et al, the vehicle component includes an engine (22), the measure concerns a rate at which the engine runs, the measure includes a measure of time during which the engine runs at a rate exceeding a predetermined rate and the rate is a function of an RPM value. See figure 2, 8-9 and columns 14-16.

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6. Claims 13 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Love et al [5,629,871].

Love et al discloses a wear trend analysis technique for components of a machine. According to Love et al, there is provided computing a measure which indicates an extent of performance degradation of a vehicle component due to an operation of the machine; adding the measure to a cumulative measure; determining whether the cumulative measure exceeds a predetermined value; providing an alert when the cumulative measure exceeds the predetermined value; and displaying a selectable option on the display element, a selection of the option causing information about the alert to be provided, thereby facilitating maintenance of the vehicle component. See abstract, figures 6-8.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Love in view of Hanson et al [5,317,998].

Love et al does not particularly teach that the machine component is an engine and that the measure concerns an engine RPM. Hanson et al, on the other hand, discloses a system and method of monitoring vehicle for maintaining components of the vehicle, wherein the system including a display element (44). According to Hanson et al, the vehicle

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component includes an engine (22), the measure concerns a rate at which the engine runs, the measure includes a measure of time during which the engine runs at a rate exceeding a predetermined rate and the rate is a function of an RPM value. See figure 2, 8-9 and columns 14-16. Both Love et al and Hanson et al are pertinent art in that they are both related to the maintenance (wear and performance) of a machine (e.g., vehicle). Thus, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the wear trend analysis of Love et al to be used for an engine of a vehicle because such modification would enable the control of the parameters of the vehicle in a more effective manner.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,055,998	Pettingell et al	Nov. 1997
4,339,657	Larson et al	Jul. 1982
4,541,386	Kishi et al	Sep. 1985
4,949,078	Ito et al	Aug. 1990
5,309,756	Osawa et al	May 1994
5,661,735	Fischer	Aug. 1997
Re.36, 347	Hanson et al	Dec. 1999

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H Louis-Jacques whose telephone number is 703-305-9757. The examiner can normally be reached on M-Th 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacques H Louis-Jacques
Primary Examiner
Art Unit 3661

/jlj

Jacques H. Louis-Jacques
JACQUES H. LOUIS-JACQUES
PRIMARY EXAMINER